

REMARKS

Claims 1-7, 9-21, and 23-33 are pending in this application. Claims 8 and 22 have been canceled, without prejudice or disclaimer of subject matter. Claims 3-5, 7, 9-13, 16-18, 20, 21, and 23-32 have been amended to define still more clearly what Applicant regards as his invention. Claims 1, 7, 14, and 21 are independent.

Applicants note with appreciation the allowance of Claims 1-6 and 14-20, and the indication that Claims 28/14, 28/15, 29/1, 29/2, 30/14, 30/15, 31/1, 31/2, 32/14, 32/15, 33/32/14, and 33/32/15 would be allowed if the dependency of these claims is changed to remove the non-allowed multiple dependencies. The latter claims have not been so rewritten because, for the reasons given below, all their base claims are believed to be allowable.

Claims 7-13 and 21-23 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 6,535,644 to Kurapati in view of U.S. Patent 6,711,299 to Chao et al. and/or U.S. Patent 6,747,762 to Josephsen et al.^{1/}

Claim 7 is directed to a method of dividing a digital signal representing physical quantities. The method includes the steps of determining at least one area of interest in the signal through an intervention by a user, and determining an initial partitioning of the signal, including partitioning areas. The method further includes the step of modifying the partitioning of the signal according to the at least one area of interest and a predetermined criterion so that the at least one area of interest is situated entirely within a partitioning area.

^{1/} While it is not necessary for Applicant to do so, Applicant expressly notes that he does not concede that the effective date of Josephsen et al. (November 5, 1999) is prior to Applicant's invention date.

Notably, Claim 7 includes modifying a partitioning of a signal according to at least one area of interest and a predetermined criterion so that the at least one area of interest is situated entirely within a partitioning area. (See the specification at, e.g., page 5, lines 7-11.)^{2/} By virtue of this feature, further processing of the image (and particularly of the region of interest) can be improved. This technical effect is not disclosed in the prior art.

Kurapati, as understood by Applicant, relates to the communication and presentation of wavelet encoded images. Different images, or sub-images, are rendered at different wavelet decoding rates, the more-rapidly decoded wavelets forming a focal region about which less detailed images, or sub-images, are formed.

Chao et al., as understood by Applicant, relates to wavelet-based image compression. At column 27, line 47, to column 28, line 4, this portion being cited in the Office Action, Chao et al. discusses compressing an image by splitting it. Using an interactive method, a user can indicate how many blocks they want to divide the image into and how many pixels they want for overlap. To compress an image according to this approach, the size of the source image is first detected. Then, the user's choice for the number of blocks and number of overlapping pixels is entered. Next, the image is divided into the pieces according to the user's choice and the size of the image. Finally, the individual pieces are compressed.

Josephsen et al., as understood by Applicant, relates to optimizing compression of scanned data. At column 2, lines 40-63, cited in the Office Action,

^{2/}It is of course to be understood that the references to various portions of the present application are by way of illustration and example only, and that the claims are not limited by the details shown or discussed in the portions referred to.

Josephsen et al. discusses a method for automatically selecting a best compression method for a scanned image. The scanned image may be one page or several pages. A scanning device acquires the image and portions are selected and compressed using a variety of techniques. The user may select all or a subset of compression techniques to be used in the analysis. The result of each technique is assigned a score, which can depend upon one or more of a group of system parameters, such as size of the resultant file, the speed of compression, or the quality of the image. The compression technique with the best score is then used to compress the entire bitmap of the entire image.

Alternatively, in Josephsen et al., the user can select a subset of a multi-page document for the compression analysis. The subset may be selected pages or a range of pages from the document. The user would designate a compression technique for the remaining pages. In this manner, only a few pages will undergo compression analysis; the other pages will be encoded as designated by the user, such as text or graphics.

Alternatively, the user can select one page of a multi-page document for the compression analysis, and designate the compression technique chosen by the analysis for the remaining pages.

At the paragraph bridging pages 3 and 4 of the Office Action, the Examiner states: “It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the scheme of Chao or Josephsen in the method of Kurapati in order to increase the compression speed and flexibility”. Applicant does not agree with the Examiner’s statement.

First, Applicant submits that a *prima facie* case of obviousness has not been made. MPEP § 2142 provides that to establish a *prima facie* case of obviousness, three

basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Applicant has carefully studied the analysis in the Office Action regarding motivation to combine these patents, but finds himself unable to agree with the Examiner's reasoning or his conclusion.

Essentially, the Examiner argues that it would have been obvious to use the scheme of Chao et al. or Josephsen et al. in the method of Kurapati in order to increase the compression speed and flexibility.

In fact, however, a more detailed analysis shows that one of ordinary skill in the art would not be motivated to attempt a combination of Chao et al. or Josephsen et al. in the manner proposed.

As explained in the Preliminary Amendment filed January 18, 2005 (see pages 12 and 13 of that Preliminary Amendment), the lines shown on Figs. 3A-3F of Kurapati are not actually displayed, as the aim of Kurapati is to display a downloaded image in a presentable fashion (see, e.g., column 1, lines 8-10, column 2, lines 42-45, and column 5, lines 10-23, of that patent). There is therefore no need, in Kurapati, for these regions to be determined by a user and, as a consequence, no reason why Chao et al. or Josephsen et al. in this respect would obviously apply to Kurapati. There is no suggestion

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Kurapati with Chao et al. or Josephsen et al., or to combine reference teachings.

Second, even assuming *arguendo* that the references' teachings could be combined, nothing in either proposed combination would teach or suggest modifying a partitioning of a signal according to at least one area of interest and a predetermined criterion so that the at least one area of interest is situated entirely within a partitioning area, as recited in Claim 7.

The Examiner asserts at page 3 of the Office Action that focal region 310 of Kurapati is an "area of interest" according to Claim 7, and that the regions shown in Figs. 3B-3F of that patent are "partitioning areas" according to Claim 7. However, even assuming *arguendo* that this interpretation is correct, the focal region 310 of Kurapati is always larger than the smaller regions (which, if the Examiner's reasoning is to be accepted, would correspond to the modified partitioning). Therefore, in any event, Kurapati does not show that the partitioning is modified so that the at least one area of interest is situated entirely within a partitioning area, as recited in Claim 7.

Nothing in Kurapati, Chao et al., or Josephsen et al., whether taken either separately or in any permissible combination (if any) would teach or suggest modifying a partitioning of a signal according to at least one area of interest and a predetermined criterion so that the at least one area of interest is situated entirely within a partitioning area, as recited in Claim 7.

Accordingly, Claim 7 is seen to be clearly allowable over Kurapati.

Independent Claim 21 is a device claim corresponding to method Claim 7, and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 7.

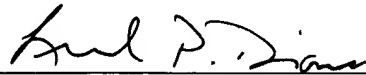
A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other rejected claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Leonard P. Diana", is written over a horizontal line.

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